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PATENT
Attorney Docket No. 05793.3038-00000

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Colleen C. LUBKING et al.) Group Art Unit: 3692
)
Application No.: 09/882,304) Examiner: MILEF, Elda G.
)
Filed: June 18, 2001) Confirmation No.: 6864
)
For: METHOD AND SYSTEM FOR)
OFFERING FINANCIAL)
PRODUCTS BASED ON A)
CUSTOMER'S DETERMINED)
LIFE STATUS)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on May 1, 2007.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee \$500.00

Extension Fee (if any) \$0

The PTO did not receive the following
listed item(s) a check of \$500


Total Fee Due \$500.00

☒ Enclosed is a check for \$500.00 to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account 06-0916.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 29, 2007

By: 

Arthur A. Smith
Reg. No. 56,877



PATENT
Attorney Docket No. 05793.3038-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed May 1, 2007, and further to Board Rule 41.37, Appellants present this brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 41.20(b)(2).

This Appeal responds to the November 2, 2006, final rejection of claims 1, 5-7, 13, 14, 17, 21-24, and 28-33 under 35 U.S.C. § 103(a).

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

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I. REAL PARTY IN INTEREST

CAPITAL ONE FINANCIAL CORPORATION is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 7, 13, 14, 17, 23, 24, and 30-33 remain pending and under examination. Claims 2-6, 8-12, 15, 16, 18-22, and 25-29 have been withdrawn. Appellants appeal the rejection of claims 1, 7, 13, 14, 17, 23, 24, and 30-33. A list of the appealed claims is presented in the attached Appendix A.

IV. STATUS OF AMENDMENTS

In response to the first Office Action mailed April 7, 2006, Appellants filed an Amendment on August 7, 2006, amending the specification, amending claims 1, 5-7, 13, 14, 17, 21-24, and 28-30, cancelling claims 2-4, 8-12, 15, 16, 18-20, and 25-27, and adding new claims 31-33. In response to the final Office Action mailed on November 2, 2006, Appellants filed an Amendment on January 29, 2007, amending claims 1, 7, 13, 17, 23, 24, and 30 and cancelling claims 5, 6, 21, 22, 28, and 29.

All amendments have been entered. No amendments under 37 C.F.R. § 1.116 have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter on appeal offers different financial products to a customer based upon the customer's determined life status. As set forth in Appellants' specification:

[t]he term 'life status' refers to a customer's demographic classification relating to life stage and financial standing, for example: high school student, college student, graduate student, employment with salary over \$50,000, employment with salary over \$100,000, home-owner, head-of-family, retiree, etc. Thus the term 'life status' may refer to the customer's current marital, employment, housing, income, or educational status. As a customer's life status changes, the customer becomes eligible for different financial products.

(See, e.g., *Appellants' specification*, ¶ 005.) Previous prior art systems and methods cannot track changes in a customer's life status, and therefore cannot revise the type of financial products offered to a customer as the customer's life status changes.

a. Claim 1

Independent claim 1 is directed to a method for providing a financial product to a customer. In accordance with certain aspects related to the present invention, the method includes receiving customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database. (See, e.g., *Id.* at ¶ 022 and Fig. 1.) The method also includes analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification. (See, e.g., *Id.* at ¶ 034 and Fig. 3.) The method further includes selecting, from a set of financial products, a first financial product for the

customer based on said life status using a data structure that relates each life status type to a particular financial product. (See, e.g., *Id.* at ¶ 034.) The method further includes monitoring, periodically, the customer information for changes and automatically revising, based on a change to the customer information, the customer's life status. (See, e.g., *Id.* at ¶ 048.) The method also includes selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product. (See, e.g., *Id.*) Additionally, the method includes determining the creditworthiness of the customer and optimizing said first and second financial products based on said creditworthiness. (See, e.g., *Id.* at ¶¶ 044, 048, and Fig. 1.)

b. Claim 17

Independent claim 17 is directed to a method for providing a financial product to a customer. In accordance with certain aspects related to the present invention, the system includes means for receiving customer information from at least one of a purchase database, an application database, a call center database, an Internet database, and a public records database. (See, e.g., *Id.* at ¶ 029 and Fig. 2, refs. 200 or 240.) The system also includes means for analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification. (See, e.g., *Id.* at ¶ 034 and Fig. 2, refs. 200 or 210.) The system further includes means for selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product. (See, e.g., *Id.* and Figs. 4-6.) The system further includes means for

monitoring, periodically, the customer information for changes and means for automatically revising, based on changes to the customer information, the customer's life status. (See, e.g., *Id.* at ¶ 048 and Fig. 2, refs. 200, or 210.) The system also includes means for selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product. (See, e.g., *Id.* and Figs. 4-6.) Additionally, the system includes means for determining the creditworthiness of the customer and means for optimizing said first and second financial products based on said creditworthiness. (See, e.g., *Id.* at ¶¶ 044 and 048; Fig. 1; and Fig. 2, refs. 200 or 210.)

c. Claim 24

Independent claim 24 is directed to a computer for providing a financial product to a customer. The computer including a memory having program instructions and a processor, responsive to the programming instructions. (*Id.* at ¶ 046 and Fig., ref. 210.) The processor being configured to receive customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database. (*Id.* at ¶ 022 and Fig. 1.) The processor also being configured to analyze the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification. (*Id.* at ¶ 034 and Fig. 3.) The processor further being configured to select, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product. (*Id.* at ¶ 034.) The

processor further being configured to monitor, periodically, the customer information for changes and automatically revise, based on changes to the customer information, the customer's life status. (*Id.* at ¶ 048.) The processor also being configured to select, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product. (*Id.*) Additionally, the processor being configured to determine the creditworthiness of the customer and optimize said first and second financial products based on said creditworthiness. (*Id.* at ¶¶ 044, 048, and Fig. 1.)

VI. Grounds of Rejection

Claims 1, 14, 17, 24, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moran* (U.S. Patent No. 6,430,542); and claims 5-7, 13, 21-23, and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moran* in view of *Kunzle et al.* (U.S. Patent Publication No. 2002/0023051).

In the Advisory Action mailed February 7, 2007, the Examiner indicated that, based on Appellants amendments presented in the Amendment filed January 29, 2007 (which are now entered), "claims 1 and 24 would be rejected under 35 U.S.C. 103(a) as being unpatentable over *Moran* in view of *Kunzle* as per the rejection applied to claims 1, 5-7, and 13 combined."¹ The Examiner also indicated that "[c]laim 24 would be rejected based on the same art and rationale." (*Advisory Action*, p 2.)

¹ Appellants note that the Examiner identified claim 24 twice in this statement, but most likely was referring to claims 1, 17, and 24. Accordingly, Appellants assume the Examiner intended to identify claims 1, 17, and 24 in the statement presented in the Advisory Action.

VII. Arguments

As noted above, the Examiner indicated in the Advisory Action that claims 1, 17, and 24 would be rejected under 35 U.S.C. 103(a) as being unpatentable over *Moran* in view of *Kunzle* “as per the rejection applied to claims 1, 5-7, and 13 combined.”

(*Advisory Action*, p. 2.) Accordingly, Appellants address the rejection of independent claims 1, 17, and 24, and dependent claims 7, 13, 14, 23, and 30-33 in the context of the Examiner’s position set forth in the Advisory Action.

Appellants respectfully request the Board to reverse the Examiner’s rejections of claims 1, 7, 13, 14, 17, 23, 24, and 30-33. *Moran* and *Kunzle et al.* taken alone or in any proper combination, fail to teach or suggest all the elements of independent claims 1, 17, and 24 and their corresponding dependent claims 7, 13, 14, 23, and 30-33. Moreover, there is no suggestion or motivation to modify the cited references to result in the claimed invention as alleged by the Examiner.

The References Must Teach or Suggest All the Claim Elements

Appellants respectfully point out that the first requirement for establishing a *prima facie* case of obviousness has not been established, namely, *Moran* and *Kunzle et al.* do not teach or suggest each and every element of Appellants’ claimed invention. This is evidenced by the arguments that follow.

a. *Moran* does not teach or suggest a financial product

Moran discloses a computer-implemented program for financial planning and advice system, referred to as Financial Advisory Service (FAS), that aids financial advisors in creating financial plans for their clients. (*Moran*, Abstract and 6:7-23.)

Contrary to the Examiner's assertion, the financial plan disclosed by *Moran* does not equate to the claimed "financial product." The plain meaning of this term, as set forth in Appellants' claims and the description of the term in Appellants' specification, supports this position. Appellants' claims recite first and second financial products that is selected for a customer based on the customer's life status, and are optimized based on the creditworthiness of the customer. Appellants' specification states that "[t]he term financial products refers to any type of financial products and services including but not limited to consumer credit services and corresponding credit card products, and bank/investment services. These financial products are directed toward consumers that require financial assistance with student loans, purchasing real estate, purchasing automobiles, and other personal loans." (*Appellants' specification*, ¶ 002.) Specific examples of financial products are credit card products mortgage equity service, and refinancing service. (*Id.* at ¶¶ 003 and 034.)

On the contrary, a financial plan is a layout of financial goals and the financial inputs and outputs needed to achieve those goals. (See, e.g., *Moran*, 11:40-50.) Accordingly, in the context of Appellants' claims and specification,² the term "financial product" as recited in the appealed claims is not a "financial plan" as described by *Moran*. Consequently, *Moran* does not teach or suggest a "financial product" as recited in independent claims 1, 17, and 24.

² See e.g., *Phillips v. AWH Corp*, 415 F.3d 1303, 1317 (Fed. Cir. 2005)(en banc).

b. *Moran* does not teach or suggest selecting, from a set of financial products

As disclosed above, *Moran* does not teach or suggest the claimed “financial product.” Accordingly, *Moran* does not teach or suggest:

selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product,

or

selecting, from a set of financial products, a second financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product,

as recited in independent claims 1 and 17 and similarly recited in independent claim 24.

In rejecting the claims, the Examiner asserts that the claimed “life status” equates to the “Economic Group (EG 200)” disclosed by *Moran*. (See, e.g., *final Office Action*, p. 3.)

Even if the Examiner’s assertion was correct, a conclusion that Appellants do not acquiesce, the above recitation of the claims are still not taught or suggested by *Moran*.

As disclosed by *Moran*, the “Economic Group 200 reflects the demographics of the group for which the planning is being done. These demographics preferably include the persons in the economic group, their relationships, and the like.” (*Moran*, 11:36-40.) Changes to members of the group may result in changes to the goals of the financial plan. (*Id.* at 14:43-46.) *Moran* further discloses that “[f]or example, when a group member gets married, the member’s change in marital status may lead to a change in the member’s tax position and may necessitate an updating of the group’s associated income tax goal.” (*Id.* at 14:46-49.) However, nowhere does *Moran* disclose or suggest

that a change in the economic group results in the “selecting, from the set of financial products, a first financial product for the customer . . . using a data structure that relates each life status type to a particular financial product,” as claimed.

Moreover, when the goals of the financial plan are to be updated, “[t]he advisor preferably then updates or enters the goals for the household or economic group.” (*Id.* at 14:61-62 and 16:16-21.) *Moran* does not teach or suggest the selection of a financial product “using a data structure that relates each life status type to a particular financial product,” as recited in independent claims 1, 17, and 24.

The Examiner’s suggested combination of *Moran* and *Kunzle et al.* is improper

Independent claim 1 recites, among other things:

determining the creditworthiness of the customer; and
optimizing said first and second financial products
based on said creditworthiness.

Independent claims 17 and 24 recite similar subject matter.

As admitted by the Examiner, *Moran* fails to disclose the above claim recitations. (*Final Office Action*, p. 5.) To cure the deficiencies of *Moran*, the Examiner relies on *Kunzle et al.* The Examiner’s alleged motivation for combining *Moran* and *Kunzle et al.* is that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Moran* to include determining the creditworthiness of a borrower as taught by *Kunzle* in order for the financial institution to reduce credit risk.” (*Id.*)

Although *Kunzle et al.* mentions the use of a customer’s creditworthiness, this is done in the context of financial products and not financial plans. (*Kunzle et al.*, ¶ 0026.) As set forth by *Kunzle et al.*, a financial product “is intended to include any financial

product offered by a financial institution. Financial products include, but are not limited to, loans (e.g., mortgage, home equity, automobile, boat, recreational vehicle, student), lines of credit, checking accounts, savings accounts, credit cards, debit cards, etc.” (*Id.* at ¶ 0030.) Accordingly, in the context of *Kunzle et al.*, creditworthiness may be used to reduce credit risk.

On the contrary, the financial plan disclosed by *Moran* does not equate to a financial product and as a result, does not include a relationship of lender to borrower. Instead, the financial plan is simply a layout of financial goals and the financial inputs and outputs needed to achieve those goals. (See, e.g., *Moran*, 11:40-50.) Therefore, in such an advisor to client relationship, where no lending or borrowing of funds occurs between the parties, there is no need to determine “the creditworthiness of a borrower as taught by Kunzle in order for the financial institution to reduce credit risk,” as alleged by the Examiner.

In rejecting Appellants’ claims, the Examiner improperly attempts to construct the claimed invention from the cited references by relying on aspects related to the present invention. Such reliance, however, constitutes improper hindsight reasoning.

Because the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 1, 17, and 24, Appellants respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be reversed by the Board.

Claims 7, 13, 14, 23, and 30-33 depend from claims 1, 17, and 24. As explained, claims 1, 17, and 24 are distinguishable from *Moran* and *Kunzle et al.* Accordingly, claims 7, 13, 14, 23, and 30-33 are also distinguishable from these references for at least the same reason set forth above in connection with claims 1, 17, and 24.

Therefore, Appellants respectfully request that the Board reverse the rejection of these claims under 35 U.S.C. § 103(a).

VIII. Conclusion

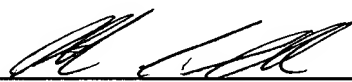
For the reasons given above, pending claims 1, 7, 13, 14, 17, 23, 24, and 30-33 are allowable and reversal of the Examiner's rejection is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 29, 2007

By: 
Arthur A. Smith
Reg. No. 56,877



Claims Appendix to Appeal Brief Under Rule 41.37(c)(1)(viii)

1. (Previously Presented) A method for providing a financial product to a customer, said method comprising:
 - receiving customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database;
 - analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;
 - selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;
 - monitoring, periodically, the customer information for changes;
 - automatically revising, based on a change to the customer information, the customer's life status;
 - selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;
 - determining the creditworthiness of the customer; and
 - optimizing said first and second financial products based on said creditworthiness.

Claims 2-6. (Canceled.)

7. (Previously Presented) A method for providing a financial product to a customer according to claim 1, further comprising:

offering said first and second financial products to said customer.

Claims 8-12. (Canceled.)

13. (Previously Presented) A method for providing a financial product to a customer according to claim 1, wherein selecting said first and second financial products further comprises:

including the customer's creditworthiness as a factor in the selection of said first and second financial products.

14. (Previously Presented) A method for providing a financial product to a customer according to claim 1, further comprising:

periodically receiving said customer information.

Claims 15 and 16. (Canceled.)

17. (Previously Presented) A system for providing a financial product to a customer, said system comprising:

means for receiving customer information from at least one of a purchase database, an application database, a call center database, an Internet database, and a public records database;

means for analyzing the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

means for selecting, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;

means for monitoring, periodically, the customer information for changes;

means for automatically revising, based on changes to the customer information, the customer's life status;

means for selecting, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;

means for determining the creditworthiness of the customer; and

means for optimizing said first and second financial products based on said creditworthiness.

Claims 18-22. (Canceled.)

23. (Previously Presented) A system for providing a financial product to a customer according to claim 17, further comprising:

means for offering said first and second financial products to said customer.

24. (Previously Presented) A computer for providing a financial product to a customer, said computer comprising:

a memory having program instructions; and

a processor, responsive to the programming instructions, configured to:

receive customer information from at least one source chosen from a purchase database, an application database, a call center database, an Internet database, and a public records database;

analyze the received customer information using a filter that categorizes a customer into a life status, wherein the life status corresponds to the customer's demographic classification;

select, from a set of financial products, a first financial product for the customer based on said life status using a data structure that relates each life status type to a particular financial product;

monitor, periodically, the customer information for changes;

automatically revise, based on changes to the customer information, the customer's life status; and

select, from the set of financial products, a second financial product for the customer based on said revised life status using the data structure that relates each life status type to a particular financial product;

determine the creditworthiness of the customer; and

optimize said first and second financial products based on said creditworthiness.

Claims 25-29. (Canceled.)

30. (Previously Presented) A computer for providing a financial product to a customer according to claim 24, wherein said processor is further configured to:
offer said first and second financial products to said customer.

31. (Previously Presented) A method for providing a financial product to a customer according to claim 1, wherein the data structure comprises a matrix or algorithm.

32. (Previously Presented) A system for providing a financial product to a customer according to claim 17, wherein the data structure comprises a matrix or algorithm.

33. (Previously Presented) A computer for providing a financial product to a customer according to claim 24, wherein the data structure comprises a matrix or algorithm.



Evidence Appendix to Appeal Brief Under Rule 41.37(c)(1)(ix)

Appellants do not rely on any evidence in this Appeal.

XI. Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

To Appellants' knowledge, there are no related proceedings or decisions.